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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Re. Appellant: Marco Scibora
Serial No.: 09/266,183
Filed: March 10, 1999
For: APPARATUS AND METHOD FOR RECORDING A CUSTOM COMPACT
DISC AT A RETAIL PREMISES
Examiner: Andrew C. Flanders
Art Unit: 2644
Confirmation No.: 5426
Attorney: Gerald E. Helget
Attorney
Docket No.: 33046.13
Additional Fees: Charge to Deposit Account 023732

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

TRANSMITTAL COVER LETTER

Enclosed for filing please find the following:

1. Appellant's Reply to Examiner's Answer Under 37 C.F.R. § 41.41 (6 pgs.); and
2. Postcard receipt.

Respectfully submitted,

Dated: 29 Nov 05

By: [Signature]
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CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the United States Postal Service as First Class Mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

By: [Signature]
Date: 29 Nov 05



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Alexandria, VA 22313-1450

Sir:

APPELLANT'S REPLY TO EXAMINER'S ANSWER UNDER 37 C.F.R. § 41.41

Appellant, by his attorney, submits one copy of this reply to the Examiner's Answer, mailed October 6, 2005, pursuant to 37 C.F.R. § 41.41 in further of the Appeal, the notice of which was filed with the United States Patent and Trademark Office on July 28, 2005, from the Final Rejection of claims 1-21 of the above-identified application, as set forth in the Final Office Action mailed on May 3, 2005. Appellant respectfully requests consideration and reversal of the Examiner's rejections of the pending claims.

CERTIFICATE OF MAILING

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By Julie E. Hugg
Date 29 Nov 05

VIII. ARGUMENT

- A. Applicant herein withdraws its arguments in regards to claims 1 to 9, 10 to 14, 15, and and 16.
- B. The Office Action rejected claim 17 under 35 USC 103(a) as being unpatentable over Tsevdos in view of Alexander and further in view of Salisbury and further in view of Cook. Applicant respectfully traverses the rejection.

Cook does not disclose a plurality of scannable purchase cards each having a unique bar code keyed to the music selections chosen by the customer. There is no disclosure in Cook that the "gift card" is scannable or has a unique bar code keyed to the music selections chosen by the customer. The cited section of Cook merely states:

In a further alternative, a customer may purchase (at retail, electronically or otherwise) a "gift" certificate for a third party, who may then access the service by going to the retail establishment and supplying the gift number or token to the network machine (or an operator thereof).

This merely states how a third party may access the system. There is no disclosure of this gift certificate having a unique bar code keyed to the music selections chosen by the third party. The actual selection and ordering process in Cook is described at col. 7 lines 20-45. An order confirmation of "job" number is assigned by the management system. There is no disclosure of using any scannable barcode number on the "gift" certificate keyed to the chosen music selections. The order process of Tsevdos is described at col. 17 line 1 to col. 18 l. 15. Appellant can find no disclosure of the use of a purchase card having a unique bar code keyed to the music selections chosen by the customer.

In his answer, the examiner states:

"Examiner respectfully disagrees. As discussed in detail before, for the gift card to function as discussed by Cook, it would require a number (possibly in the form of a barcode which is notoriously well known in the art) to distinguish in its when it was to be redeemed. Cook even states "applying the gift number". It is well known to supply this gift card number to a retail store using a barcode instead of a scannable magnetic strip implementing a scannable number with a barcode instead of the magnetic strip or just keying it in does not produce any new or unexpected result. Thus this limitation does not patentably distinguish the claim for the prior art."

Applicant respectfully disagrees once again. As already presented in the appeal brief, at page 5, lines 20 through 30, Cook merely discloses a method to gain access to the system. There is absolutely no disclosure of such a gift certificate being scannable or having a unique barcode keyed to the music selections chosen by the customer. Also as previously presented, such a gift certificate is not used for ordering the CD, in fact the CD is ordered as disclosed at column 7 lines 20 - 45. The customer, that is the original customer, or a third party possessing a gift certificate, receives an order confirmation No. by which the job is managed by the system and tracked by the customer. There is no disclosure of any part of the order been keyed onto the gift certificate. When the CD is ready the customer is notified, typically by an e-mail message, with the tracking number. If the order had been keyed to the gift card or certificate, there would be no need for the customer to be notified with the tracking number. Plus the office action is incorrect that implementing a scannable number with a barcode would have been suggested to one of ordinary skill in the art by the disclosure of Cook, as there is no such disclosure, and the system operates completely differently.

In fact the examiner essentially admits to this at page 20 paragraph 1. The examiner states "when redeeming the gift card, they [sic] information contained therein would be entered (keyed) into the system." If the gift card were keyed to (i.e., related to) the music selections chosen by the customer, there would be no need to enter this information when the gift card is redeemed.

The examiner is also incorrect in his understanding that Appellant is using a barcode in the exact same manner as the purchase card disclosed by Cook. Unlike Cook, when the customer purchases a purchase card 130 from the retail establishment, the purchase card 130 is encoded with a unique barcode. Cook does not disclose encoding the gift certificate with a unique barcode. The examiner further states "Cook discloses the exact same method a customer may purchase... a gift certificate for a third-party, who may then access the service by going to the retail establishment and supplying the gift number or token to the network machine...." Again this is as stated only accessing the service, not accessing the music selections that have been chosen.

C. The Office Action rejected claims 18-21 under 35 USC 103(a) as being unpatentable over Tsevdos in view of Alexander and further in view of Kaplan and further in view of Cook. Applicant respectfully traverses the rejection.

1. Separate argument as to claim 18.

Again applicant respectfully disagrees with the examiner's answer. Examiner states "as to claim 18, claim 18 recites the limitations in question of the customer obtaining a purchase card with a unique barcode number and an authorized amount from retail premises personnel. The purchase card would have an inherent value, or in other words an authorized amount instructing a customer to scan the purchase card at the previous station (that is supplying the number to the machine in Cook), notifying the customer if the total length of all selected tracks exceeds the authorized amount on the purchase card (that is, it is inherent that if there are insufficient funds present, the cashier or machine will notify the customer the card does not have sufficient funds to complete the purchase. This is well known in the art and further as evidenced when a credit card is declined due to insufficient credit."

These are mere the assumptions made by the examiner without supporting evidence of disclosure in the reference. Again the gift certificate of Cook is not used in producing the music selections. This is used only in accessing the system.

Once again, Cook does not disclose the steps (e), (f), (g), and (h). Cook does not disclose scanning the purchase card to obtain the unique barcode; keying each selected track to the unique barcode, scanning the purchase card at a checkout station to obtain the unique barcode; and recording the selected tracks keyed to the unique barcode on a compact disc cutter.

2. Separate Argument as to claim 19.

Cook does not disclose steps (a), (h), (j), (k), (l) or (q). There is no disclosure in Cook that the "gift card" is scannable or has a unique bar code keyed to the music selections chosen by the customer. The cited section of Cook merely states:

In a further alternative, a customer may purchase (at retail, electronically or otherwise) a "gift" certificate for a third party, who may then access the service by going to the retail establishment and supplying the gift number or token to the network machine (or an operator thereof).

This merely states how a third party may access the system. There is no disclosure of this gift certificate having a unique bar code keyed to the music selections chosen by the third party. The actual selection and ordering process in Cook is described at col. 7 lines 20-45. An order confirmation of "job" number is assigned by the management system. There is no disclosure of using any scannable barcode number on the "gift" certificate keyed to the

chosen music selections. The order process of Tsevdos is described at col. 17 line 1 to col. 18 l. 15. Appellant can find no disclosure of the use of a purchase card having a unique bar code keyed to the music selections chosen by the customer.

Applicant refers the examiner to the comments above in regard to claim 18 which are also applicable to claim 19.

3. Separate argument as to claim 21.

Cook also does not disclose the further limitation of claim 21 of the customer purchasing the purchase card after selecting tracks to be purchased. The “gift” card is apparently purchased before selecting any tracks and then given to a third party for that party to choose his or her music selections.

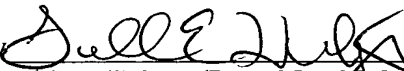
The examiner states "the time when the gift card is purchased in the Cook reference for it to be applied is unimportant. For instance, a user may select the tracks, purchase the gift card, and redeem it or on the other hand, a user may first purchase the gift card, select the tracks and then redeem the card. The order is irrelevant and does not patentably distinguished the claim from the prior art because the order would not produce any new or unexpected result and the reference reads upon the claimed language."

Applicant disagrees. The only disclosure in Cook of a gift card is at column 5 lines 22 through 30. Cook clearly discloses that a customer first purchases the gift certificate and then a third-party accesses the service by going to the retail establishment and supplying the gift number or token to the network machine and selecting tracks to be purchased. Far from being irrelevant, the order of operation in Cook is absolutely required for operation; it is impossible for the third-party to have the gift certificate and access the service until the customer purchases the gift certificate.

In view of the foregoing, Appellant asks the Board to overturn the Examiner's rejections and allow all claims.

Respectfully submitted,

Dated: 29 Nov 05

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